

The Most Significant Proposed Changes to the Canadian *Trade-Marks Act* since 1953

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The Canadian government has recently proposed changes to the *Trade-Marks Act* through its omnibus legislation entitled "*Economic Action Plan 2014, No. 1*" (Bill C-31), although further amendments to this legislation are always possible before it is officially enacted in the months to come. The previous most significant changes had been done in 1953. Only TRIPS-related amendments had been adopted in 1993. Otherwise, no significant changes had taking place for over 60 years.

However, Canada had to take steps to standardize its intellectual property practices with the ones occurring internationally. During the adoption of the Federal Budget in last February, it was announced that Canada would amend its legislation to ratify the Madrid Protocol, the Singapore Treaty, the Nice Agreement, the Patent Law Treaty as well as The Hague Agreement. This update had been expected for a long time.

At last, a "trade-mark" will become a "trademark" and "wares" will become "goods". The definition of "trademark" will be reviewed and extended to cover non-traditional types of marks and the concept of "distinguishing guise" will disappear.

One of the significant changes provides that an applicant, whether domestic or foreign could now register a trade-mark in Canada without the need to use the trade-mark in Canada or abroad prior to registration. This also means that the applicant would no longer be required to select a filing base at the time of filing.

Another change relates to the Nice Classification. Canada was already using unofficially the Nice classification but would now at last officialise it. The adherence to the Nice classification would probably mean that, as for the United States, additional government fees would be charged in proportion to the categories of goods and services covered by the trademark. Currently, the government filing fee is 250\$ CA, regardless of the number of goods and services. This could also potentially mean that the Canadian Trade-Marks Office might issue additional Examiner's Reports or Office Actions relating to the classification, therefore possibly delaying approval of applications.

It is likely that Canada was pressed to promptly move forward with these reforms, mainly in the context of the negotiations which led to a free trade agreement between Canada and the European Union known as the “*Comprehensive Economic and Trade Agreement*” (CETA)). Critics point however to the fact that the proposed legislation was not given much time for public consideration despite the significant nature of the changes. The Canadian government’s proposal to get rid of current filing grounds and permit registration without the need to have used the trademark, anywhere, might generate its own set of issues. That being said, trademark practitioners need to be aware of these significant changes. We will therefore closely monitor Bill C-31 in the coming months as it works its way through the Canadian Parliament.

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